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FROM : Oleg F. Kaplun, Esq. of Fay Kaplun & Marcin, LLP
DATE : July 21, 2008
SUBJECT : U.S. Patent Appln. Serial No. 10/762,715
for *Valved Catheter to Bypass Connector*
Inventor(s): DiMatteo et al.
Our Ref.: 10142/03601

NUMBER OF PAGES INCLUDING COVER: 20

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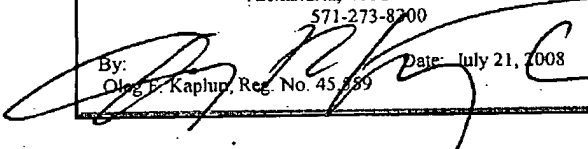
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Attorney Docket No. 10142/03601 (03-225)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : DiMatteo et al.
Serial No. : 10/762,715
Filed : January 22, 2004
For : Valved Catheter to Bypass Connector
Group Art Unit : 3767
Confirmation No. : 5203
Examiner : Phillip A. Gray

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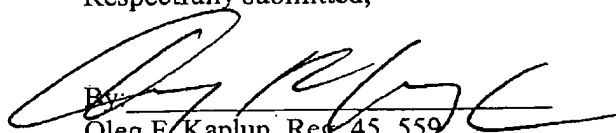
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Respectfully submitted,

Dated: July 21, 2008

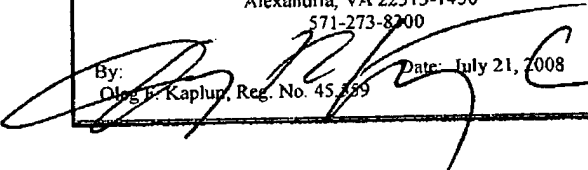

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Attorney Docket No. 10142/03601 (03-225)

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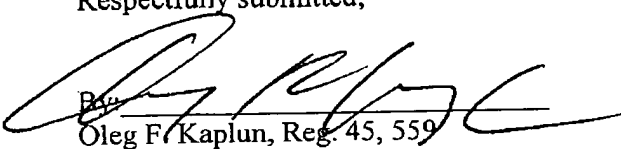
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PATENT
Attorney Docket No.: 10142/03601

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re Application of:)	
)	
DiMatteo et al.)	
)	
Serial No.: 10/762,715)	Group Art Unit: 3767
)	
Filed: January 22, 2004)	Examiner: Phillip Gray
)	
For: VALVED CATHETER TO)	Board of Patent Appeals and
BYPASS CONNECTOR)	Interferences
)	

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed June 18, 2008, and pursuant to 37 C.F.R. § 41.37,
Appellants present their Appeal Brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's
final rejection of claims 1 - 5, 7 - 19, and 21 - 24 in the Final Office Action dated March 21,
2008. The appealed claims are set forth in the attached Claims Appendix.

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Group Art Unit: 3767
Attorney Docket No.: 10142/03601

1. Real Party in Interest

This application is assigned to Boston Scientific Scimed, Inc., the real party in interest.

2. Related Appeals and Interferences

An initial Appeal Brief in connection with the present application was filed on June 1, 2007. The application was subsequently reopened for examination and a Non-Final Office Action issued on September 24, 2007.

3. Status of the Claims

Claims 1 - 5, 7 - 19, and 21 - 24 stand rejected in the Final Office Action. The final rejection of claims 1 - 5, 7 - 19, and 21 - 24 is being appealed.

4. Status of Amendments

All amendments submitted by the Appellants have been entered.

5. Summary of Claimed Subject Matter

The present invention describes, as recited in independent claim 1, a connector for injecting fluid to a catheter. The connector 100 comprises an attachment portion 104 adapted to fluidly couple to a source of pressurized fluid. (See Specification, p. 6, ll. 14-28; Fig. 1). The connector comprises a bypass element (e.g., 108) fluidly connected to the attachment portion. (See *Id.*, p. 7, l. 1 - p. 8, l. 3; Figs. 1-2). The bypass element is adapted to open a valve of the catheter to permit fluid to flow into the catheter without impinging on the valve. (See *Id.*). The

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connector comprises an overpressure control element (e.g., 306) adapted to maintain a pressure of fluid within the connector below a predetermined threshold level. (*See Id.*, p. 9, ll. 7-16; Fig. 1).

The present invention describes, as recited in independent claim 18, a fluid coupler 100. The fluid coupler 100 comprises an elongated tube 102 extending between a first end 104 adapted for fluid connection to a power injector and a second end adapted for fluid connection (via extensions 106) to a catheter 200 including a valve 202 in a proximal part thereof. (*See Id.*, p. 6, ll. 14-28; p. 7, l. 22 - p. 8, l. 3; Figs. 1 - 2). The second end is insertable into the catheter beyond the valve thereof so that fluid passes through the fluid coupler into the catheter to a distal end thereof without passing through the valve. (*See Id.*). The fluid coupler comprises a pressure control element (306) adapted to limit a fluid pressure within the fluid coupler to a predetermined threshold level. (*See Id.*, p. 9, ll. 7-16; Fig. 1).

6. Grounds of Rejection to be Reviewed on Appeal

- I. Whether claims 1 - 5, 7 - 8, 11 - 13, 18 - 19, 21 and 23 are unpatentable under 35 U.S.C. § 102(b), or alternatively, under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,125,893 to Dryden.
- II. Whether claims 9 - 10, 22 and 24 are unpatentable under 35 U.S.C. § 103(a) over Dryden in view of U.S. Pat. No. 6,375,637 to Campbell et al. ("Campbell").
- III. Whether claims 14 - 17 are unpatentable under 35 U.S.C. § 103(a) over Dryden.

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7. Argument

I. The Rejection of Claims 1 - 5, 7 - 8, 11 - 13, 18 - 19, 21 and 23 Under 35 U.S.C. § 102(b), or alternatively, under 35 U.S.C. § 103(a) as Unpatentable Over Dryden Should Be Reversed

A. The Examiner's Rejection

In the Final Office Action, claims 1 - 5, 7 - 8, 11 - 13, 18 - 19, 21 and 23 were rejected under 35 U.S.C. 102(b), or alternatively, under 35 U.S.C. § 103(a) as unpatentable over Dryden. (See 3/21/08 Office Action, pp. 4-5). The Examiner has indicated that the valve 35 of Dryden functions as an overpressure control element therein. The Examiner has further indicated that the recitation of the term "adapted to" is not a positive limitation and only requires the ability to so perform. (See 3/21/08 Final Office Action, p. 3).

B. Dryden Fails to Teach or Suggest An Overpressure Control Element Adapted to Maintain a Pressure of Fluid Within the Connector Below a Predetermined Threshold Level, as Recited in Claim 1.

It is respectfully submitted that the recitation of an "overpressure control element adapted to maintain a pressure of fluid within the connector below a predetermined threshold level" is indeed a positive limitation intended to limit the structure of the connector of claim 1. Specifically, claim 1 explicitly indicates that the overpressure control element must be formed of a size and shape indicative of a maximum pressure flow therethrough, wherein structural limitations of the overpressure control element provide the overpressure feature. Were the overpressure control element formed with difference specifications (i.e., having a substantially

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large lumen extending therethrough), the overpressure control element would become incapable of functioning as such. It is therefore noted that the limitation of an "overpressure control element adapted to maintain a pressure of fluid within the connector below a predetermined threshold level" is a structural limitation.

Still further, it is noted that the term "overpressure control element" is itself a structural limitation indicative of an element for controlling a pressure of the controller to prevent an overpressure therein. Specifically, the plain meaning of the term "overpressure control element" provides that said element is structurally formed to prevent an overpressure in the controller of claim 1. (See MPEP, § 2111.01). Accordingly, even if the "adapted to" limitation were to be removed from claim 1, the "overpressure control element" limitation alone would still be a sufficient structural limitation to overcome Dryden, as will be described in greater detail below. It is therefore respectfully submitted that the limitation of an "overpressure control element adapted to maintain a pressure of fluid within the connector below a predetermined threshold level" is a structural limitation.

Furthermore, it is respectfully submitted that the valve 35 of Dryden does not meet the limitations of the overpressure control element recited in claim 1. Specifically, the valve 35 of Dryden is described only as controlling an amount of irrigation fluid supplied to the catheter 28. Dryden makes absolutely no mention of any control of the pressure in the catheter 28 at all, much less by a valve such as the valve 35 which is described only as having a simple on/off functionality. (See Dryden, col. 2, ll. 55 - 56). Dryden neither shows nor suggests any valve for

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maintaining a pressure within a connector below a threshold level as recited in claim 1 at all. Additionally, such a function would not be of any use in regard to the small amounts of irrigation fluids supplied by the Dryden device. It is respectfully submitted that the Examiner's statements regarding this functionality of the valve 35 are purely speculative and in no way supported by the disclosure of Dryden.

The Examiner has further relied on a 35 U.S.C. § 103(a) rejection to overcome this deficiency in the Dryden device, asserting that it would have been obvious to have constructed the valve 35 as a pressure control element. (*See* 3/21/08 Office Action, p. 4). However, it is respectfully submitted that, as described above, Dryden provides no motivation to modify its device to include "an overpressure control element," as recited in claim 1. Specifically, as the relevant portions of the Dryden device (i.e., the irrigation fluid supply apparatus including the source 12, the valve 35 and the lumen 29) is directed solely to a low pressure application, it is submitted that those skilled in the art would not have found any motivation to modify the on/off valve 35 to enable it to perform such an overpressure control function. Thus, it is respectfully submitted that obviousness can not be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is no teaching, suggestion, or motivation to do so and that this represents an impermissible hindsight reconstruction of the invention. (*See In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)).

It is therefore respectfully submitted that Dryden fails to show or suggest a connector for injecting fluid to a catheter comprising "*an overpressure control element adapted to maintain a*

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pressure of fluid within the connector below a predetermined threshold level," as recited in claim 1 and that claim 1 is allowable over Dryden. Because claims 2 - 5, 7 - 8 and 11 - 13 depend from and, therefore, include the limitations of claim 1, it is respectfully submitted that these claims are allowable for at least the reasons stated above.

Independent claim 18 includes limitations substantially similar to those of claim 1 discussed above. Specifically, claim 18 recites "an elongated tube extending between a first end adapted for fluid connection to a power injector and a second end adapted for fluid connection to a catheter including a valve in a proximal part thereof, the second end being insertable into the catheter beyond the valve thereof so that fluid passes through the fluid coupler into the catheter to a distal end thereof without passing through the valve and a *pressure control element adapted to limit a fluid pressure within the coupler to a predetermined threshold level.*" Applicants respectfully submit that claim 18 is allowable over Dryden for the same reasons noted above in regard to claim 1. Because claims 19, 21 and 23 depend from and, therefore, include the limitations of claim 18, it is respectfully submitted that these claims are allowable for at least the reasons stated above.

II. The Rejection of Claims 9 - 10, 22 and 24 Under 35 U.S.C. § 103(a) as Unpatentable Over Dryden in view of Campbell Should Be Reversed

A. The Examiner's Rejection

In the Final Office Action, claims 9 - 10, 22 and 24 were rejected under 35 U.S.C. 103(a) as unpatentable over Dryden in view of Campbell. (See 3/21/08 Office Action, p. 6).

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B. Dryden Fails to Teach or Suggest An Overpressure Control Element Adapted to Maintain a Pressure of Fluid Within the Connector Below a Predetermined Threshold Level, as Recited in Claim 1.

As stated above in regard to claim 1 from which claim 9-10 depend, Dryden fails to teach or suggest the limitations of claim 1. The Campbell device is directed to a catheter balloon having a controlled failure mechanism therein. (See Campbell, col. 4, ll. 55 - 58). The Campbell device fails to overcome the deficiencies of the Dryden device, particularly "an overpressure control element adapted to maintain a pressure of fluid within the connector below a predetermined threshold level," as recited in claim 1. It is therefore submitted that Dryden and Campbell, either alone or in combination, fail to teach or suggest the limitations of claim 1. Because claims 9 and 10 depend from and therefore include all of the limitations of claim 1, it is respectfully submitted that these claims are also allowable.

Claim 18 recites limitations substantially similar to claim 1, including "an elongated tube extending between a first end adapted for fluid connection to a power injector and a second end adapted for fluid connection to a catheter including a valve in a proximal part thereof, the second end being insertable into the catheter beyond the valve thereof so that fluid passes through the fluid coupler into the catheter to a distal end thereof without passing through the valve and a *pressure control element adapted to limit a fluid pressure within the coupler to a predetermined threshold level.*" It is respectfully submitted that Dryden and Campbell, either alone or in combination, fail to teach or suggest the limitations of claim 18. Because claims 22 and 24 depend from and therefore include all of the limitations of claim 18, it is respectfully submitted

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that these claims are also allowable.

III. The Rejection of Claims 14 - 17 Under 35 U.S.C. § 103(a) as
Unpatentable Over Dryden Should Be Reversed

A. The Examiner's Rejection

In the Final Office Action, claims 14 - 17 were rejected under 35 U.S.C. 103(a) as unpatentable over Dryden. (See 3/21/08 Office Action, p. 7).

B. Dryden Fails to Teach or Suggest An Overpressure Control Element Adapted to Maintain a Pressure of Fluid Within the Connector Below a Predetermined Threshold Level, as Recited in Claim 1.

Claims 14 - 17 depend from, and therefore include all of the limitations of claim 1. As noted above, Dryden fails to teach or suggest the limitations of claim 1. Thus, it is respectfully submitted that claims 14 - 17 are allowable for at least the same reasons stated above in regard to claim 1. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 14 - 17.

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8. Conclusion

For the reasons set forth above, Appellants respectfully request that the Board reverse the final rejections of the claims by the Examiner under 35 U.S.C. § 103(a) and indicate that claims 1-5, 7-19, and 21-24 are allowable.

Respectfully submitted,

Date: 7/21/08

By: 

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